

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application

Applicant(s): P.T. Keyser et al.
Docket No.: YOR920000048US1
Serial No.: 09/624,963
Filing Date: July 25, 2000
Group: 2178
Examiner: Kyle R. Stork

Title: Methods and Apparatus for Automatic
Page Break Detection

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The remarks below are submitted in response to the Notification of Non-Compliant Appeal Brief dated June 26, 2007, in the above-identified application.

For the reasons identified herein, Applicants (hereinafter "Appellants") believe that the Notification of Non-Compliant Appeal Brief is improper and should be withdrawn.

Appellants will file a new Appeal Brief in a timely fashion and no later than August 6, 2007, in accordance with 37 CFR 41.37(a)(1) and MPEP 1204.01.

REMARKS

In the Notification of Non-Compliant Appeal Brief dated June 26, 2007 (hereinafter “Notification”), the Examiner contends that the “Appeal Brief filed on 04 June 2007 is defective for failure to comply with one or more provisions of 37 CFR 41.37” (Notification, page 1, first paragraph, emphasis in original) because “[a]lthough the applicant [sic] has requested reinstatement of the Appeal Brief filed 10 May 2006, this is not compliant with MPEP 1204.01” (Notification, page 2, first paragraph). MPEP 1204.01, as correctly quoted by the Examiner in the Notification at page 2, second paragraph, states in relevant part:

If an appellant wishes to reinstate an appeal after prosecution is reopened, appellant must file a new notice of appeal in compliance with 37 CFR 41.31 and a complete new appeal brief in compliance with 37 CFR 41.37. . . . Appellant must file a complete new appeal brief in compliance with the format and content requirements of 37 CFR 41.37(c) within two months from the date of filing the new notice of appeal.

Appellants respectfully submit that the Notification misstates the facts, misapplies relevant regulations and, accordingly, is defective and should be withdrawn.

Issuance of a Notification of Non-Compliant Appeal Brief is only appropriate when a defective Appeal Brief has been filed; the Response to Final Office Action (hereinafter “Appellants’ Response”) dated June 4, 2007 was not an appeal brief. Indeed, 37 CFR 41.37(d) and MPEP 1205.03, which provide the regulatory basis for issuance of a Notification of Non-Compliant Appeal Brief, address only those instances in which “a brief is filed which does not comply with all the requirements.” On the other hand, instances in which appeal brief has not been filed are instead discussed in 37 CFR 41.37(a) and MPEP 1205.01.

Accordingly, even if the Examiner had correctly characterized the substance of the Appellants’ Response, the issuance of a Notification of Non-Compliant Appeal Brief, with the attendant shortened statutory period, was inappropriate and impermissible under applicable sections of the CFR and MPEP. Accordingly, the Notification should be withdrawn on at least procedural grounds.

Moreover, however, the Notification mischaracterizes the Appellants' Response as having "requested reinstatement of the Appeal Brief filed 10 May 2006" (Notification, page 2, first paragraph, with emphasis added). Appellants respectfully note that Appellants' Response did not request reinstatement of the Appeal Brief. Rather, it indicated that "Applicants hereby request reinstatement of the appeal. A Notice of Appeal is submitted concurrently herewith." (emphasis added)

Appellants respectfully note again that MPEP 1204.01 provides that "[i]f an appellant wishes to reinstate an appeal after prosecution is reopened, appellant must file a new notice of appeal in compliance with 37 CFR 41.31 and a complete new appeal brief in compliance with 37 CFR 41.37. . . . Appellant must file a complete new appeal brief in compliance with the format and content requirements of 37 CFR 41.37(c) within two months from the date of filing the new notice of appeal."

Accordingly, Appellants respectfully submit that the Appellants' Response, in which Appellants indicated their wish to reinstate the appeal (not the appeal brief) and filed a new notice of appeal concurrently therewith, was compliant with MPEP 1204.01, which specifically provides that Appellant must file a complete new appeal brief within two months from the date of filing the new notice of appeal.

Because the new Notice of Appeal was filed with the Appellants' Response on June 4, 2007, MPEP 1204.01 and 37 CFR 41.37(a)(1) provide that Appellants must file a complete new appeal brief no later than August 4, 2007. Because August 4, 2007 is a Saturday, this period is extended until Monday, August 6, 2007, as provided by 35 U.S.C. 21(b) and 37 CFR 1.7(a).

On the other hand, the Notification is apparently predicated on the Examiner's erroneous belief that Appellants were required to submit a new Appeal Brief concurrently with the Notice of Appeal in order to reinstate their appeal. This interpretation is both unsupported by and inconsistent with the relevant regulations, as well as being materially prejudicial to Appellants.

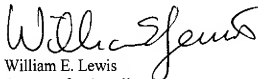
Moreover, the Notification requires that, in order to "avoid dismissal of the appeal, applicant [sic] must file an amended [sic] brief or other appropriate correction (see MPEP 1205.03) within **ONE MONTH** or **THIRTY DAYS** from the mailing date of this notification" (Notification, page 2, second paragraph, emphasis in original). Specifically, by issuing the

Notification, the Examiner has imposed a requirement that Appellants “must file a complete new appeal brief in compliance with 37 CFR 41.37” (Notification, page 2, third paragraph) no later than July 26, 2007, which is one month from the mailing date of the Notification, June 26, 2007. As noted above, this requirement contradicts applicable regulations and materially prejudices Appellants. Accordingly, Appellants submit that the Notification should be withdrawn.

Furthermore, Appellants note that an attorney for Appellants, David E. Shifren (Reg. No. 59,329), engaged in several telephone discussions with Examiner Kyle Stork, who prepared the Notification, and Supervisory Patent Examiner Stephen Hong, who signed the Notification (hereinafter “the Examiners”). During these conversations, the Examiners agreed that Appellants should be permitted to file a timely Appeal Brief on or before August 6, 2007. Although the Examiners indicated that this agreement would be made of record and placed into the file by means of an interview summary, to date, this does not appear to have occurred.

For the above reasons, Appellants respectfully request withdrawal of the Notification of Non-Compliant Appeal Brief. Appellants intend to submit a complete new appeal brief no later than August 6, 2007 in compliance with the above-cited CFR and MPEP sections.

Respectfully submitted,



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